

In re application of: Ioana Popa-Burke et al.
Application No.: 10/008,348
Filed: 08 November 2001
Page 6 of 10

REMARKS

Status of the Claims

Responsive to the Restriction Requirement mailed June 21, 2004, claims 1-25 and 42-55 have been canceled without prejudice to or disclaimer of the subject matter therein as described elsewhere. Applicants expressly reserve the right to file divisional applications or take such other appropriate measures deemed necessary to protect the inventions of these claims. Claim 27 has been amended without prejudice to or disclaimer of the subject matter therein as described elsewhere herein. Support for the amendments is found in the original claims and in the specification at page 7, lines 15-8 and the paragraph spanning pages 12-13. Therefore, no new matter has been added by amendment. Claims 26-41 are now pending.

The Examiner's comments are addressed below in the order set forth in the Office Action.

The Rejection of Claims 27-28 Under 35 U.S.C. § 112, First Paragraph, Should be Withdrawn

Claims 27-28 stand rejected under 35 U.S.C. § 112, first paragraph. This rejection is respectfully traversed.

The Office Action states that "[t]he specification does not disclose or give any guidance for 'updating an indicia with...a measurement,' or having the indicia 'operably engaged' with a plate, when the indicia is just a barcode...." It is then reasoned that "[n]o one of ordinary skill in the art would know how to 'update' a barcode, which carries unaltered coded information for an item (the plate), or how to 'operably engage' it with the plate." Applicants disagree. First, the claim does not include any limitation that "the indicia is just a barcode." Rather, the specification explains indicia as follows.

Each plate 100 may further include a plate identification indicia 130 comprising, for example, a bar code or other indicia, capable of providing appropriate identification of the plate 100. In some instances, the individual minitubes 120 may also, or in the alternative to the plate identification indicia 130, comprise a minitube identification indicia 140 capable of providing appropriate identification of the minitube 120. Such a minitube identification indicia 140 would be useful, for example, in the event that a minitube 120 becomes separated from, and must

In re application of: Ioana Popa-Burke et al.
Application No.: 10/008,348
Filed: 08 November 2001
Page 7 of 10

be re-united with, the corresponding plate 100. However, for the sake of brevity, embodiments of the present invention utilizing the plate identification indicia 130 will be described herein, though it will be understood that many different methods and mechanisms, such as the minitube identification indicia 140, may be used to track and record minitubes within a plate in accordance with the spirit and scope of the present invention. Thus, according to one embodiment of the invention, the receptacles 110 may be arranged within the plate 100 according to a coordinate system, an example of which is generally indicated by the numeral 150, so as to indicate the location of each minitube 120 within the plate 100. In such an instance, the plate identification indicia 130 may cooperate with the coordinate system 150 to identify the individual minitubes 120 therein, without requiring the minitube identification indicia 140.

See the specification, page 6, lines 14-31. Second, as is well known in the art, there are numerous means and methods for operably engaging an indicia with a plate or selected vessel. Thus, the claim is enabled.

However, to expedite prosecution, claim 27 has been amended to read "[a] method according to Claim 26, wherein at least one of the plate and the selected vessel comprise an indicia configured so as to indicate information corresponding to the selected vessel, said method further comprising updating the information corresponding to the selected vessel with at least one of the tare measurement, the gross measurement, and the weight of the portion of the profiling sample." There is no longer a recitation of "updating" or "operably engaging" an indicia. Thus, the concerns expressed in the Office Action are alleviated. The rejection of claims 27-28 under Section 112, first paragraph, should be withdrawn, accordingly.

The Rejection of Claims Under 35 U.S.C. § 112, Second Paragraph, Should be Withdrawn

Claims 27-28 have been rejected as indefinite under 35 U.S.C. § 112. This rejection is respectfully traversed.

Within the Office Action, it is asserted that "[i]t is not clear, what 'updating an indicia with...a measurement,' or 'the indicia operable engaged with a plate' might mean" and that "[i]t is also not clear, how the barcode can be 'operably engaged' with the plate[.]" Applicants disagree for the reasons stated with respect to the Section 112, first

In re application of: Ioana Popa-Burke et al.
Application No.: 10/008,348
Filed: 08 November 2001
Page 8 of 10

paragraph rejection. In any case, claim 27 has been amended to read "[a] method according to Claim 26, wherein at least one of the plate and the selected vessel comprise an indicia configured so as to indicate information corresponding to the selected vessel, said method further comprising updating the information corresponding to the selected vessel with at least one of the tare measurement, the gross measurement, and the weight of the portion of the profiling sample." Thus, the concerns expressed in the Office Action are alleviated. The rejection of claims 27-28 under Section 112, second paragraph, should be withdrawn, accordingly.

The Rejections of the Claims under 35 U.S.C. § 102(b) Should Be Withdrawn

Claims 26-41 stand rejected under 35 U.S.C. § 102(b) over GlaxoSmithKline, Calvert (1999). The rejection is respectfully traversed.

A copy of GlaxoSmithKline, Calvert (1999) was not provided with the Office Action, nor does the rejection cite to any particular portion of the document. Rather, Hunter (2001) is cited for its description of Calvert. The Office Action further cites Borman (2001) for its description of weighing and Mettler-Toledo, Inc. (2001) for its description of an automated balance. This is not proper.

To establish anticipation, the rejection must show that each element set forth in the rejected claim is found in a single prior art reference. MPEP § 2131. Furthermore, a publication may only be cited under Section 102(b) if its publication occurred more than one year prior to the date of the application for patent. MPEP 2133.

While Applicants have been unable to review Calvert, the Office Action does not demonstrate that each element of any of claims 26-41 can be found in this reference. For instance, the Office Action does not demonstrate that Calvert (or any of the cited references) teaches each element of claim 26. Each of claims 27-41 depend from claim 26. Because of this deficiency, the rejection should be withdrawn.

Applicants further note that the present application was filed November 8, 2001. The other references cited in the rejection appear to have been published in 2001 and are therefore not Section 102(b) references. Clarification regarding the citation of these references is requested.

In re application of: Ioana Popa-Burke et al.
Application No.: 10/008,348
Filed: 08 November 2001
Page 9 of 10

For all of the reasons stated above, the rejection of claims 26-41 under Section 102(b) should be withdrawn.

Miscellaneous

Applicants note that U.S. Patent Nos. 6,514,977 and 6,399,024 have been cited but not relied upon by the Examiner.

CONCLUSION

In view of the aforementioned amendments and remarks, Applicants respectfully submit that the objection to the specification and the rejections of the claims under 35 U.S. C. §§ 112, first and second paragraph, and 102(b) are overcome. Accordingly, Applicants submit that this application is now in condition for allowance. Early notice to this effect is solicited.

If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned.

Applicants herewith petition the Director of the United States Patent and Trademark Office to extend the time for reply to the Office Action dated August 9, 2001 for one month from November 9, 2004 to December 9, 2004. Please Charge my deposit Deposit Account No. 50-0885 in the amount of \$60.00 to cover the cost of the extension. It is not believed that extensions of time or fees for net addition of claims are required, beyond those, which may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are

In re application of: Ioana Popa-Burke et al.
Application No.: 10/008,348
Filed: 08 November 2001
Page 10 of 10

necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 50-0885.

Respectfully submitted,



Eric J. Kron
Registration Number 45,941
Attorney for Applicants
Icoria, Inc.
108 T.W. Alexander Drive
Post Office Box 14528
Research Triangle Park, NC 27709
(phone) 919.425.3000
(fax) 919.485.0812
Customer Number 22881